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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,019	11/28/2000	Daniel L. Cox	ACS-53509	3548

24201 7590 06/03/2003

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT PAPER NUMBER

3738

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/727,019	Applicant(s) DANIEL L. COX	
	Examiner Jackson J Suzette	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Applicants RCE dated 5/16/03 has been received in application serial number 09/727,019.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musinger 6,228,110 in view of Roberts et al. 5,545,209 and further in view of Mickley et al. 5,961,536.
4. **Musinger** discloses mounting a stent upon an expandable member (col. 7, line 20); covering the stent and expandable member with a moveable sheath which is disposed in a co-axial arrangement over the stent and expandable member (col. 3, lines 61-67); advancing the stent and expandable member into the area of treatment in the body vessel; retracting the sheath to expose the mounted stent on the expandable member; inflating the expandable member to expand the stent within the body vessel; and deflating the expandable member (see col. 10, lines 19-25) *and*; a catheter including an elongated catheter shaft having a proximal end and distal end with an inner inflation lumen extending therein; an expandable member having a proximal end and a distal end, a length and a desired inflated diameter disposed near the distal end o the

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elongated catheter shaft which is in fluid communication with the inner inflation lumen, the expandable member being adapted to receive a stent for mounting thereon; a moveable sheath adapted to cover a portion of the stent during delivery and having an inner lumen with smaller diameter than the desired inflated diameter of the expandable member, however Musinger does not specify that the sheath is movable over a portion of the expandable member so that only a portion of the expandable member not covered by the sheath expands to a desired inflated diameter upon inflation. **Roberts** teaches a catheter assemble system including a stent and sheath/constraint where in the sheath/constraint is capable of constraining the balloon so that it may be progressively incrementally inflated (see col. 2, lines 32-33 and col. Col. 9, lines 11-27 and Figure 3). However, Musinger and Roberts do not specify an expandable member having a length greater than the length of the stent. **Mickley et al.** teaches this feature (see col. 1, lines 57-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the invention of Munsinger and incorporate the methods that only a portion of the expandable member not covered by the sheath expands to a desired inflated diameter upon inflation incrementally as taught by Roberts because it would ensure proper deployment of full expansion of the stent within the vessel. It is also obvious if not inherent that different length stents are utilized in the art along with varying length expandable members. The intended use recitation/functional language *“to create a working length of the expandable member which is at least as long as the length of the...”* carries no patentable weight in the absence of any distinguishing structure. “Roberts et al” clearly discloses the structure as claimed and is found to be inherently capable of performing the function of “moving over a portion of the expandable member so that only a portion of the expandable member not covered by the sheath expands”.

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*Allowable Subject Matter*

5. Claim 4 is allowed.

*Response to Arguments*

6. Applicant's arguments filed 5/16/03 have been fully considered but they are not persuasive. Applicant contends that Roberts fails to disclose the use of the sheath to cover the part of the expandable member which may not be needed to deploy the stent while still creating a working length that is at least as long as the mounted stent. It is the examiner's opinion that Roberts et al. indeed teaches the device as claimed including covering part of the expandable member (see figures 3-6, element 14 which covers part of the member). Applicant argues function language with regards to a article claims regardless the functional language has been taken into consideration with respect to the method claims and 103 rejection is deemed proper.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

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8. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3580.
9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J. Jackson

28 May 2003